

REMARKS

Consideration of the present application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1 and 12 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification thereby not narrowing the scope of the claim, to detect infringement more easily, to enlarge the scope of infringement, to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.), to expedite the issuance of a claim of particular current licensing interest, to target the claim to a party currently interested in licensing certain embodiments, to enlarge the royalty base of the claim, to cover a particular product or person in the marketplace, and/or to target the claim to a particular industry. Descriptive support for the amendments to claims 1 and 12 can be found at least in FIG. 1.

Claims 1-20 are now pending in this application. Claims 1 and 12 are the independent claims.

I. The Anticipation Rejection

Claims 1, 4-6, 8-12, 15-17 and 19-22 of the parent application, Serial No. 09/466,631, filed 17 December 1999, were rejected as anticipated under 35 U.S.C. §102(e). In support of the rejection, Lo et al. (U.S. Patent No. 6,031,818) was cited. This rejection is respectfully traversed.

Lo fails to establish a prima facie case of anticipation. See MPEP 2131. To anticipate expressly, the "invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as

in the claim". *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter "with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention". *Crown Operations Int'l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, ___ (Fed. Cir. Jan. 6, 2003) ("A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.")

Specifically, claim s 1 and 12 recite "a storage device not directly connected to [a] media server". Lo does not teach expressly or inherently "a storage device not directly connected to [a] media server" according to claims 1 or 12. Accordingly, it is respectfully submitted that the rejection of claims 1 and 12 is unsupported by Lo and should be withdrawn. Also, the rejection of any claims ultimately depending from one of independent claims 1 or 12 is similarly unsupported by Lo and also should be withdrawn.

II. The Obviousness Rejection

Claims 2 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Lo et al. (U.S. Patent No. 6,031,818) in view of Banga et al. (U.S. Patent No. 6,240,447). These rejections are respectfully traversed.

The present application and U.S. Patent No. 6,240,447 (Banga) were, at the time the invention of the present application was made, owned by or subject to an obligation to assign to AT&T Corp., and thus Banga is unavailable for use as a 103 reference.

As stated above, claim s 1 and 12, and thus claims 2 and 13 respectively, recite "a storage device not directly connected to [a] media server". Lo does not teach expressly or inherently teach or suggest "a storage device not directly connected to [a] media server" according to claims 1 and 12. Thus, Lo does not expressly or inherently teach or suggest **every** limitation of the claims. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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